notary seal and venue. Furthermore, 37 CFR 1.4 permits facsimile declarations. 37 CFR 1.4 (d) reads as follows:

> (d)(1) Each piece of correspondence, except as provided in paragraphs (e) and (f) of this section, filed in an application, patent file, trademark registration file, or other proceeding in the Office which requires a person's signature, must:
>
> (i) Be an original, that is, have an original signature personally signed in permanent ink by that person; **or**
>
> **(ii) Be a direct or indirect copy, such as a photocopy or facsimile transmission (§ 1.6(d)), of an original.** In the event that a copy of the original is filed, the original should be retained as evidence of authenticity. If a question of authenticity arises, the Office may require submission of the original;

Paragraphs (e) and (f) mentioned in paragraph (d)(1)do not change this. They read:

> (e) Correspondence requiring person's signature and relating to registration practice before the Patent and Trademark Office in patent cases, enrollment and disciplinary investigations, or disciplinary proceedings must be submitted with an original signature personally signed in permanent ink by that person.
>
> (f) When a document that is required by statute to be certified must be filed, a copy, including a photocopy or facsimile transmission, of the certification is not acceptable.

The Examiner has raised no question of authenticity, so paragraphs (e) and (f) mentioned in paragraph (d)(1)do not apply. Thus it is respectfully requested that objection to the declaration be withdrawn.

Reconsideration is respectfully requested of the objection to the drawings. Formal drawings will be submitted upon allowance.

Reconsideration is respectfully requested of the objection to the specification as not containing an abstract of the disclosure. An abstract of the disclosure is being submitted as a separate sheet.

Reconsideration is respectfully requested of the rejection of claims 1 to 5 and 15 to 20 as unpatentable under 35 USC 103 over Lawlor in view of Hebling and Bush, and claims 21 to 31 as unpatentable under 35 USC 102 over Lawlor.

The claims are believed to be distinct and non-obvious from any of the references, alone or in combination by virtue of "entering a tendered amount into a station of a network **controlled by the payee**, said amount being **greater** than an amount due the payee;" as well as of "**subtracting** the amount due the payee from at least a portion of the tendered amount to obtain an additional amount;", and also "transmitting the **additional amount** to a separate station forming part of a network **controlled by other than the payee** and, within the separate station, crediting at least a part of the additional amount into one or more of the payor accounts determined by the payor." in claims 1 to 5; and

"a step of automatically adjusting the balance of the operating account, on the basis of the one transaction to form a **rounder amount**, and the balance of at least **one rounder account** of the first party on the basis of the automatic adjustment." in claims 15 to 20.

and "entering data that identifies a credit or debit amount into a station **controlled by the payee**;" as well as "transmitting the data that identifies the credit or debit amount to a separate network **controlled by other than the payee**;" and also "within the separate network, modifying the data associated with one or more **payor accounts** selected by the payor as a credit or debit;" and further "transferring any data representing a debit back to the payee." in claims 21 to 31.

These features provide a direct pass-through of the additional amounts to their ultimate payee destinations without the payee's awareness of the destinations, and without accounting or tax consequences to the payee. The payor is secure in the knowledge that each individual payor transaction is confidential as far as the payee is concerned. There is a shift in control from the payee to control outside the payee.

None of the references, alone or in combination, suggests these features nor in any sense make the claims obvious. Lawlor contains **none** of the features set forth in claim 1 nor in claim 21. For example:

Lawlor does not suggest, "entering a tendered amount into a station of a network controlled by the payee, said amount being greater than the amount due the payee". The Examiner alleges that this appears in column 41 line 65 to column 42 line 2, Fig. 14B/536, column 44 lines 38-41, Fig. 14C/564, and column 42 line 68 to column 43 line 6. These passages read as follows.

Column 41 line 61 - column 42 line 8

If the user selects the "pay bill" option (decision block 391), central computer 52 executes the "bill process routine" (block 392), a flow chart of which is shown in FIG. 13.

Referring now to FIG. 13, the "bill process" routine 392 performs the function of processing, reviewing and correcting billing information--and also permitting the user to electronically request funds to be debited from his bank account and used to pay bills to particular desired creditors on specified dates. Upon selecting the "pay bill" main menu option, bill process routine 392 may provide account balance information to the user by forming a standard account balance ATM or POS type message (or possibly using a "null" POS debit message) containing the user's account number and PIN and transmitting this request over the ATM network to the

Column 44 lines 38-41

If, on the other hand, the user responds "Future" to the question, central computer 52 asks the user whether the bill is to be paid in the future (decision block 536).

Column 42 line 68 - column 43 line 6

In the preferred embodiment, the user is asked through direct mailings (or in certain cases by telephone) to provide, ahead of time, the names, addresses, account numbers, and other information specifying payees he wishes to pay bills to electronically (the user is also asked for other relevant account information for other services such as funds transfers).

All of these passages fail to suggest tendering the amounts into a station of a network controlled by the payee nor said amount being greater than the amount due the payee. Lawlor merely instructs a network to pay a payee who has no control over the network. Furthermore, nothing is going into the network from the payor. Also, Lawlor does not tender any amounts greater than a demanded amount. In effect Lawlor merely discloses a system containing credits for his accounts and uses those to instruct the system to pay the payee. This contrasts with the present invention where the amount tendered is directed to the payee for entry into a system controlled by the payee. After the

payee retains what is due, the payee then transfers the excess amount to a second system that is not controlled by the payee. The payee has no knowledge of the ultimate destination of any individual transfer.

In the present application, the tendered amount goes into a network controlled by the payee and if there is a purchase the tendered amount is split, one part to the payee and the other to the network outside the control by the payee. If the payor does not make purchase with the payee, the amount tendered is transferred to the network outside the control of the payee. In Lawlor, there is no confidentiality between the parties. The party receiving any tendered amount always knows the destination and even the amounts in the accounts.

The Examiner does not even allege that Lawlor suggests "**subtracting** the amount due the payee from at least a portion of the tendered amount to obtain an additional amount;" and therefore has no basis for contending that the claims are obvious. In that alone the Examiner admits patentability.

The Examiner alleges that Lawlor suggests "transmitting the **additional amount** to a separate station forming part of a network **controlled by other than the payee** and, within the separate station, crediting at least a part of the additional amount into one or more of the payor accounts determined by the payor." in column 48 lines 1 to 7. These lines read:

> [If the user requests correction of the] amount (as tested for by decision block 694), the preferred embodiment central computer 52 transmits a display format for display on terminal display 102 specifying the available funds remaining in the user's bank account (not including the previously scheduled payment amount), the name of the payee, and a user request to enter desired payment amount (block 696).

These lines offer not the slightest hint or suggestion of transmitting the **additional amount,** nor of crediting the additional amount. In Lawlor, as the Examiner admits, there was no subtraction and cannot be an additional amount.

In addition the Examiner admits that Lawlor fails to teach the use of a surplus account but alleges that this would be obvious. However, it is well established that a reference must suggest such an account. In any case, Lawlor fails even to suggest the entry of the subtracted additional amounts from the tendered amount into the payor account.

The Examiner is failing to make a distinction between the payee, for example the merchant, and the network outside the control of the payee, for example the central computer or banking system. In Lawlor if any amounts are paid, they go to the banking system and the banking system pays the payee. In the present invention, payment is made directly to the merchant who then keeps the money that is due to him and sends the amount greater than is due to him to the bank beyond his control for deposit in the payor's account.

The remaining references add nothing to the aforementioned to make the claims obvious. According to the Examiner Helbling suggests charities and subaccounts. However, in Helbling the payee keeps the money and pays the charities or their banks periodically such as monthly. This appears, for example, at column 5 lines 31 to 35 as follows:

> "At appropriate intervals, say monthly, the central station computer 37 will report to the restaurant chain 39 or to the individual restaurant at 13, the amounts due for the charitable contributions and payment can be made by direct-wire transmissions to and from the bank or by check."

Furthermore the payee always knows each destination of a donation. In fact the payee may announce the destination as part of a promotion. Payment remains in the payee's control.

Hence Helbling fails to suggest any of the aforementioned features, either alone or together with Lawlor.

Bush further adds nothing to the aforementioned to make the claim methods obvious. Bush discloses a purchasing system wherein a video menu is sent to a receiver representing a list of the available products and services. The receiver contains a credit or debit card reader and transmits financial account information, as well as the selection from the menu, via a modem to a payment processor. The payment processor verifies the programming selection and account information and transmits an authorization signal to the vendor or service provider. The payment processor would verify financial account information and forward payment authorization to a financial institution. The vendor, in

turn sends the selected product to the consumer upon receiving payment from the financial institution.

This has nothing to do with creating excesses from tendered amounts, which excesses continue under control of the payor and out of control of the payee.

Reconsideration is respectfully requested of the rejection of claims 1 to 5 under 35 USC 103 and over the judicially created doctrine of double patenting. In this regard, the Examiner cites *In re Vogel* 164 USPQ 619 (CCPA 1970) here the court sets out the question specifically. The court states that, **"same invention" means identical subject matter**. The invention defined by a claim reciting "halogen" is not the same as that defined by a claim reciting, "chlorine" because the former is broader than the latter. Accordingly, it is submitted that the Examiner is entirely wrong in rejecting these claims for double patenting.

> "The first question in the analysis is: Is the same invention being claimed twice? 35 U.S.C. 101 prevents two patents from issuing on the same invention. See, e.g., In re Boylan, 55 CCPA 1041, 392 F.2d 1017, 157 USPQ 370 (1968). As we have said many times, "invention" here means what is defined by the claims, whether new or old, obvious or unobvious; it must *not* be used in the ancient sense of "patentable invention," or hopeless confusion will ensue. By **"same invention" we mean identical subject matter. Thus the invention defined by a claim reciting "halogen" is not the *same* as that defined by a claim reciting "chlorine," because the former is broader than the latter.** On the other hand, claims may be differently worded and still define the same invention. thus a claim reciting a length of "thirty-six inches" defines the same invention as a claim reciting a length of "three feet," if all other limitations are identical. In determining the meaning of a word in a claim, the specification

may be examined. It must be borne in mind, however, especially in non-chemical cases, that the words in a claim are generally not limited in their meaning by what is shown in the disclosure. Occasionally the disclosure will serve as a dictionary for terms appearing in the claims, and in such instances the disclosure may be used interpreting the coverage of the claim. In re Baird, supra. A good test, and probably the only objective test, for "same invention," is whether one of the claims could be literally infringed without literally infringing the other. If it could be, the claims do not define identically the same invention. This is essentially the test applied in In re Eckel 55 CCPA 1068, 393 F-2d 848, 157 USPQ 415 (1968). There the court rejected the idea of "colorable variation" as a comparison category and stated that inventions were either the same, or obvious variations, or unobvious variations. The court's holding in Eckel was that same invention means identically same invention.

If it is determined that the same invention is being claimed twice, 35 U.S.C. 101 forbids the grant of the second patent, regardless of the presence or absence of a terminal disclaimer. If the same invention is not being claimed twice, a second question must be asked.

The second analysis question is: Does any claim in the application define merely an obvious variation of an invention disclosed and claimed in the patent? In considering the question, the patent disclosure may not be used as prior art. In re Boylan, supra; In re Aldrich, 55 CCPA 1431, 398 F.2d 855, 158 USPQ 311 (1968). This does not mean that the disclosure may not be used at all. As pointed out above, in certain instances, it may be used as a dictionary to learn the meaning of terms in a claim. It may also be used as required to answer the second analysis question above. We recognize that it is most difficult, if not meaningless, to try to say what is or is not an obvious variation of a claim. A claim is a group of words defining only the boundary of the patent monopoly. It may not describe any physical thing and indeed may encompass physical things not yet dreamed of. How can it be obvious or not obvious to modify a legal boundary? The disclosure, however, sets forth at least one tangible embodiment within the claim, and it is less difficult and more meaningful to judge whether that thing has been modified in an obvious manner. It must be noted that this use of the disclosure is not in contravention of the cases forbidding its use as prior art, nor is it applying the patent as a reference under 35 U.S.C. 103, since

> only the disclosure of the invention claimed in the patent may be examined.
>
> If the answer to the second question is no, there is no double patenting involved and no terminal disclaimer need be filed. If the answer is yes, a terminal disclaimer is required to prevent undue timewise extension of monopoly."

In the present application, the claims are clearly not identical to the claims in patent. The Examiner admits as much by stating that elements are omitted. Accordingly the claims with the omitted elements are broader and not identical. Hence, the first question in *Vogel,* namely whether the same invention being claimed twice, is answered in the negative.

As to the second *Vogel* question, whether any claim in the application defines merely an obvious variation of an invention disclosed and **claimed** in the patent, it is submitted that the answer is no. As pointed out in *Vogel*, the patent disclosure may **not** be used as prior art. If a claim does define merely an obvious variation of an invention disclosed and **claimed** in the patent, a terminal disclaimer is necessary. However, in the present case, the Examiner is rejecting the claims over the specification rather than the invention claimed in the patent. Under those circumstances, it is submitted that a terminal disclaimer is unnecessary.

In view of the above, it is respectfully requested that the claims be allowed and the case passed to issue.

Respectfully submitted,

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